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EXAMINER				
NGUYEN, TAN D				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/839,697

Applicant(s)

LOWRANCE ET AL.

Examiner

Tan Dean D. Nguyen

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-20 and 22-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-20, 22-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/88)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/28/08 has been entered. This is in response to the applicant's communication filed on 7/28/08 wherein claims 1, 3-20, and 22-40 are pending and claims 1, 20, and 39-40 have been amended.

Claim Status

Claims 1, 3-20, 22-40 are pending. They comprise 4 independent claims sets:

- 1) System¹: 1, 3-19. Claim 2 has been canceled.
- 2) Method: 20 and 22-38. Claim 21 has been canceled.
- 3) article/product: 39 and
- 4) System²: 40.

As of 7/28/08, independent system claim 1 is as followed:

1. (Currently Amended) An analytical system for facilitating decision making by generating and accessing arguments, wherein each of the arguments supports an associated conclusion as to whether [[the]] a given situation will likely have a negative or positive result, the analytical system comprising:

a) a database for storing a plurality of templates, each of the plurality of templates including that a plurality of queries which when responded to generate a particular argument supporting an associated conclusion regarding a particular situation, that-is the associated conclusion based on responses to its associated template queries; and

b) an argument server comprising:

(b) means for a user to select one of the plurality of templates which is most relevant to the given situation;

(c) means for receiving responses to one or more queries of the one of the plurality of templates from said user;

(d) means for receiving supporting evidence from said user in response to said one or more queries of the one of the plurality of templates, the supporting evidence being relied on by the user to form at least one of the responses;

(e) means for associating said supporting evidence received from said user with said answers responses to said one or more queries;

(f) means for evaluating said responses to determine whether the given situation will likely have a positive or negative result;

(g) means for generating a new argument supporting a conclusion of the evaluating, the new argument comprising the one of the plurality of templates, the responses, the supporting evidence, and the conclusion; and

(h) means for publishing said new argument, including said one of the plurality of templates, said responses, said supporting evidence, and said conclusion, for review.

Note: for convenience, letters (a)-(h) are added to the beginning of each element. Note also that this is an apparatus claim.

2. Note: Independent claim 1 is an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987). Also, this is an apparatus claim and intended use limitation for the system/device or apparatus, i.e. "for managing plural approval services... service provider" carries no patentable weight.

3. Therefore, the following phrases do not have patentable weight:

- 1) on the preamble, the phrase "for facilitating ... or positive result".
- 2) on element (a) of database, the phrase "for storing a plurality of templates, ..., ...queries".

3) on element (a) of database, the phrase "which when responded to generate ... template queries".

4) on element (b), the term "argument" in "argument server" is an intended use of the server.

5) on element (f), the phrase "to determine whether ...result" is not a positively recited functional element but, rather, is mere intended use of the evaluated response and thus having no patentable weight. See MPEP 2173.05 (q), 2106, and 2111.04. If the function "determining" is deemed to be critical, then "a means for determining" is needed as indicated earlier.

6) Passive cited elements "queries are formed in a hierarchical structure" as shown in dep. claim 3, 11, 13, 14, 15, 16, and 18, do not have patentable weight in an apparatus claim.

7) Note also that the phrase "to allow one or more of the plurality of users to generate and associate comments" basically reads "permits the users to do a task" and wherein the "task" is "generate and associate comments". In other word, "allowing an action" is different from actually "performing the action". "Causing" or "permitting" only requires serving as the reason for an action though, not necessarily performing the action. This can be done by issuing commands or orders, or entering into contracts. So even though the entity may do something later with the equipment that is in the technological arts, the positively recited steps of merely "causing" can be done without operating the equipment and is not in the technological arts. Variations on this theme have been seen in other cases, using terms like "allowing" or "permitting" an action,

e.g. "allowing a user to search a database". Again, these steps are distinct from actually doing the action and having no patentable weight.

4. Also, limitations such as "argument", "conclusion", "situation", supporting evidence", "positive result", "negative result", "new argument", "for review", they are considered as non-functional descriptive material (NFDM) on the data of "...", thus having no patentable weight. The mere insertion of "argument" or "conclusion" or "situation" data over "data" does not "impart functionality when employed as a computer component", thus having no patentable weight.

See MPEP 2106.01 "Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

Independent method claim 20 is as followed:

20. (Currently Amended) A method for facilitating decision making by accessing or generating an argument supporting a conclusion for a given situation, the method comprising:

a) presenting to a user a plurality of searchable templates, wherein *each* template of the plurality of searchable templates includes a plurality of queries;

b) receiving from said user a selection of one of said plurality of searchable templates, said one of said plurality of searchable templates being a relevant template most related to the given situation;

c) receiving from said user one or more responses to one or more queries of the relevant template;

d) receiving from said user supporting evidence in response to said one or more queries, the supporting evidence being relied on by the user to form at least one of the one or more responses;

e) associating said supporting evidence received from said user with at least one of said one or more queries for which a response has been received;

f) evaluating said one or more responses to determine whether the given situation will likely have a positive or negative result;

g) forming a new argument supporting a conclusion of the evaluating, the new argument comprising the relevant template, the one or more responses, the supporting evidence, and the conclusion; and

(h) publishing said new argument, including said at least relevant template, said one or more responses said supporting evidence, and said conclusion, for review.

Note: for convenience, letters (a)-(h) are added to the beginning of each step.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful (1) process, (2) machine, (3) manufacture, or (4) composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 20, 22-38 (method) are rejected under 35 U.S.C. 101 because in order for a method to be considered a "process" under §101, a claimed process must either:

(1) be tied to another statutory class (such as a particular apparatus) or

(2) transform underlying subject matter (such as an article or materials). See (1)

Diamond v. Diehr, 450 U.S. 175, 184 (1981); (2) *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); (3) *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

With respect to claims 20, 22-38, the claim language does not include the required (1) tie or (2) transformation, and thus is directed to nonstatutory subject matter. Insertion of the use of another statutory class (computer) such as "computer-implemented" or "using a computer" features in the preamble and the body of the claims would overcome the rejections.

Claim Rejections - 35 USC § 112

7. Claims 1, 3-19, 20, 22-38, 39 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) As for independent claims 1, 20, 39 and 40, it's not clear the relationship of the 1st element or step to the 2nd element/step or the "plurality of searchable templates" to the selection of one of the plurality of searchable templates being a relevant template most related to the given situation? As shown on Fig. 7A, element 702, the presented template (s) appear to be relevant/related for a given situation and wherein step (b) "most related to the given situation". Therefore, it appears in the plurality of searchable templates in the 1st step/element are "the templates that are relevant/related to a given situation" and not just any general or generic plurality of searchable templates. Correction is requested to improve clarity.

2) As for independent claims 1, 20, 39 and 40, it's not clear the relationship of the element/step (f) and (g) or "evaluating the responses ... "positive or negative result"" to "generating a new argument"? It's not clear the relationship of the "result" of (f) to "a conclusion" of (g)?

3) As for independent claims 1, 20, 39 and 40, it's not clear how element/step (f) is carried out?

4) As for independent claims 1, 20, 39 and 40, element/step (g) is vague? Is there and 'old argument' previously and it's not clear why there are no discussion of "arguments" in element/step (b)-(f)?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3-14, 17-20, 22-33 and 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over GROSSER et al in view of KEGAN and/or CALVER.

9. As for independent system claim 1, GROSSER et al fairly discloses an analytical system for facilitating decision making by generating and accessing arguments, wherein each of the arguments supports an associated conclusion as to whether a given situation will likely have a negative or positive result, the analytical system comprising:

a) a database {for storing a plurality of templates, each of the plurality of templates including that a plurality of queries which when responded to generate a particular argument supporting an associated conclusion regarding a particular situation, that-is the associated conclusion based on responses to its associated template queries}; and

{see Figs. 1a, 1b, 3 or 4, element 301, cols. 5-6}

b) a server comprising:

(b) means for a user to select one of the plurality of templates (forms, screens, fields, interfaces) which is most relevant to the given situation;

(Figs. 1a, 6, 16e, 16f and 16i, cols. 5-6)

(c) means for receiving responses to one or more queries of the one of the plurality of templates from said user;

{Figs. 1a, 1b, 6, 16e, 16f and 16i, cols. 5-6}

(f) means for evaluating said responses {to determine whether the given situation will likely have a positive or negative result};

{Figs. 1a, 1b, 6, 16e, 16f and 16i, cols. 5-6}

(g) means for generating another set of information (new argument) supporting a conclusion of the evaluating, the new argument comprising the one of the plurality of templates, the responses, and the conclusion; and

{see Figs. 1a, 1b, 6, 12, 13, 14, 16j}

(h) means for publishing another set of information (said new argument), including said one of the plurality of templates, said responses, and said conclusion, for review.

{see Figs. 1a, 1b, 6, 12, 13}

GROSSER et al fairly teaches the claimed invention except for

(d) means for receiving supporting evidence from said user in response to said one or more queries of the one of the plurality of templates, the supporting evidence being relied on by the user to form at least one of the responses; and

(e) means for associating said supporting evidence received from said user with said answers responses to said one or more queries.

In another system/method for improving persuasive argumentation and decision making and particularly to a tool to estimate the strength of a persuasive argument, and to automatically assist in making persuasive arguments stronger, **KEGAN** discloses the elements/steps of:

(d) means for receiving supporting evidence from said user in response to said one or more queries of the one of the plurality of templates, the supporting evidence being relied on by the user to form at least one of the responses; and

(e) means for associating said supporting evidence received from said user with said answers responses to said one or more queries,

(f) means for evaluating said responses {to determine whether the given situation will likely have a positive or negative result};

In order to achieve the scope/benefits cited above.

{see Figs. 2, "Evidence", "Fact", "Issue", "Law", "Matter", etc., icons, 5a and 5b, Fig. 14 "Fact Listing with Evidence, By GreenLight's Cudgel", Fig. 15 "Law with Facts, by GreenLight's Cudgel", and Fig. 25, abstract, col. 1, lines 20-27, Fig. 27 "elements 32, 37 and 40, cols. 8-10}.

It would have been obvious to modify the teachings of GROSSER et al by including elements/steps of (d), (e) and/or (f) above for at least one of the benefit cited above which is for improving persuasive argumentation and decision making and particularly to a tool to estimate the strength of a persuasive argument, and to automatically assist in making persuasive arguments stronger.

In another system/method for managing a decision making and providing proper “best solutions” to a business queries/questions, CALVER is cited to shown the use of interactive template including a plurality of queries/questions for information inputs and providing a response/answers to the queries on a web-based portal to assist business for making decisions and obtaining the three benefits as cited on [0075-0078].

{see Figs. 4, 7, 10, 12, 16, [0060]-[0064] and [0077]-[0087].

It would have been obvious to modify the information input format of GROSSER et al /KEGAN by using the template of CALVER for at least one of the benefit cited in the “interactive” features cited above.

The inclusion of the evidence features as taught by KEGAN in the remaining steps would have been obvious in view of the displaying teachings of all essential features for argument/decision-making as shown on Figs. 1a-1c of GROSSER et al.

As for dep. claim 3 (part of 1 above), which deal with feature of the one or more queries, are formed in a hierarchical structure, this carries no patentable weight in an apparatus claim as indicated above. Furthermore, the general “hierarchical structure” appears to be taught in Figs. 1c and 1b of GROSSER et al or CALVER [0077]-[0081].

As for dep. claim 4 (part of 1 above), which deal with feature of the response information, i.e. associated with a rationale or reason, etc., this is taught in KEGAN Figs. 4, 14, 15, and 25.

As for dep. claim 5 (part of 1 above), which deal with feature of the one or more queries input, is received ..., this carries no patentable weight in an apparatus claim as

indicated above. Furthermore, this feature is taught in Figs. 1c, 1b and 6 of GROSSER et al or CALVER [0077]-[0081].

As for dep. claims 6-7 (part of 1 above), which deal with features of the server, these are inherently included in the teachings of GROSSER et al /KEGAN as shown in Fig. 1a or 1b of GROSSER et al. Note that the term "to allow" has no patentable weight as indicated above.

As for dep. claims 8-11 (part of 1 above), which deal with feature of the one or more queries, are formed in a hierarchical structure, multiple choice question, etc., these carry no patentable weight in an apparatus claim as indicated above. Furthermore, these features appear to be taught in Figs. 2 "question", 4, cols. 10-12, of GROSSER et al or CALVER Figs. 16, 12, paragraphs [0077]-[0081].

As for dep. claims 12-16 (part of 1 above), which deal with feature of the one or more queries, these features appear to be taught in Figs. 2 "question", 4, cols. 10-12, of GROSSER et al or CALVER Figs. 16, 12, paragraphs [0077]-[0081]. Note that the term "to allow" has no patentable weight as indicated above. Also, the terms "is answered" or "is selected", "is associated with" are not positive apparatus claim limitations or features and thus having no patentable weight. They are interpreted as "being capable" of and the query or response or structure of GROSSER et al /KEGAN is capable of having any of this feature.

As for dep. claims 17-19 (part of 1 above), which deal with feature of the one or more queries, these features appear to be taught in Figs. 2 "question", 4, cols. 10-12, of GROSSER et al or CALVER Figs. 16, 12, paragraphs [0077]-[0081]. Note that the term

"to allow" has no patentable weight as indicated above. Also, the term "is associated with" and "is created" are not positive apparatus claim limitations or features and thus having no patentable weight. They are interpreted as "being capable" of and the query or response or structure of GROSSER et al /KEGAN is capable of having any of these features. Note that the term "to allow" has no patentable weight as indicated above. Furthermore, the general "hierarchical structure" appears to be taught in Figs. 1c and 1b of GROSSER et al or CALVER [0077]-[0081].

As for independent method claim 20, computer readable medium claim 39, and system claim 40, they are basically have the same limitations/scope as in system claim 1 above, and are rejected for the same reason set forth in the rejection of claim 1 to avoid citation of duplicate rejections.

As for dep. claims 22-38 (part of claim 20 above), which appear to have the same limitation as in dep. claims 3-19 (part of claim 1 above), they are rejected for the same reasons set forth in the rejections of claims 3-19 above to avoid citation of duplicate rejections.

10. Claims 3, 11-16 and 22 and 30-35 are rejected (2nd time) under 35 U.S.C. 103(a) as being unpatentable over GROSSER et al /KEGAN and/or CALVER as applied to claims 1, 3-19 and 20, 22-38 above, and further in view of JANSSEN.

As for dep. claims 3 and 22, the teachings of GROSSER et al/KEGAN and/or CALVER is cited above. In another similar system/method for facilitating analysis and decision making processes, JANSSEN discloses the use of linking of data representing a plurality of argument structure units into a hierarchical argument structure for the two

benefits of facilitating decision-making, particularly when the decision-making utilizes for support a large number of sources and to provide a method wherein scientific assessment can be effectively utilized in a decision making process {see abstract, col. 6, lines 25-60, Figs. 1, 2, 4, 7, and 12d or 12F. It would have been obvious to modify the teachings of GROSSER et al /KEGAN and/or CALVER to modify the structure of the queries to a hierarchical structure as taught by JANSSEN to obtain at least one of the benefit cited above, which is facilitating decision-making, particularly when the decision-making utilizes for support a large number of sources and to provide a method wherein scientific assessment can be effectively utilized in a decision making process.

As for dependent claims 11-16 and 30-35, they are rejected for the same reasons set forth above and in further in view of the teachings of hierarchical argument structure as taught by JANSSEN above.

Response to Arguments

11. Applicant's arguments with respect to claims 1, 3-20, 22-40 have been considered but are moot in view of the new ground(s) of rejection.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday. Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805. The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689